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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,528	05/20/2004	Edmund J. Fish	06975-410001 / Communicat	5580
26171	7590	08/09/2006	EXAMINER PESIN, BORIS M	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 2174	
			PAPER NUMBER	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,528

Applicant(s)

FISH, EDMUND J.

Examiner

Boris Pesin

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-36 and 39-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-36, 44-53, 55-64 and 66-90 is/are allowed.
- 6) ☒ Claim(s) 39, 41-43, 54, 65 and 91-97 is/are rejected.
- 7) ☒ Claim(s) 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This communication is responsive to the amendment filed 5/12/2006.

Claims 6-36 and 39-97 are pending in this application. Claims 36, 39, 44, 53-55, 64-66 and 73 are independent claims. In the amendment filed 5/12/2006, Claims 6, 11, 14-16, 19, 23, 25, 28-32, 36, 39, 44, 49-53, 55, 60-64, 66-69, and 73 were amended.

This action is made Non-Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The indicated allowability of claims 39, 41-43, 54, 65, and 91-97 is withdrawn in view of the newly discovered reference(s) to Doss et al. (US 6731323) and Enright et al. (US 6583813). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 2174

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 39, 41-43, 54, 65, and 91-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss et al. (US 6731323) in view of Enright et al. (US 6583813).

In regards to claim 39, Doss teaches a computer-implemented method, for providing notification information corresponding to a communication identity, the method comprising:

accessing notification setting information stored in a computer storage medium that identifies a temporal condition including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period (See Column 10, Lines 24-44);

determining whether the condition is satisfied (See Column 10, Lines 24-44);

controlling dissemination of notification information related to the communications identity based on whether the condition is satisfied (See Column 10, Lines 24-44);

accessing delegation information associated with the communication identity, the delegation information including multiple categories of communication identities and for at least one of the multiple categories, identifying notification information modifications to be controlled (See Column 8, Lines 8-44); and

receiving from a user identity associated with a category of the multiple categories, a modification of notification information regarding the notification setting information (See Column 10, Lines 24-44).

Doss does not teach accessing delegation information associate with the category; determining whether the user identity is permitted to perform the modification based on the delegation information associated with the category; and only permitting the modification to the notification setting information when the user identity is permitted to perform the modification. Enright teaches, "The described form of the present invention presents a useful user interface which may be used to set up the system configuration. Generally such configuration is established from a user terminal which is connected to the image server through a network. In this example the image server configuration provides for three levels of activities which users are authorized to perform. These levels correspond to categories of privileges and are "administrator", "operator" and "service". A screen 278 shown in FIG. 16 shows the categories of activities and the user groups which are permitted to perform them in accordance with the configuration of an exemplary embodiment of the invention." (Column 35, Lines 3-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doss with the teachings of Enright and include a mechanism for permitting the modification to the notification setting information when the user identity is permitted to perform the modification based on the delegation information associated with categories with the motivation to provide the user a more secure working environment.

In regards to claim 41, Doss and Enright teach a method of claim 39. Doss and Enright do not teach a method wherein multiple categories comprise multiple categories that include a government category, a financier category, and a user category. However Doss and Enright do teach that there are categories (see rejection claim 39). The phrase "categories that include a government category, a financier category, and a user category" is nonfunctional descriptive material and is not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 403 (Fed. Cir. 1983); *In re Lowry*, 32, F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claims 42 and 43 are similar in scope to claim 41; therefore they are rejected under similar rationale.

Claims 54 and 65 are similar in scope to claim 39; therefore they are rejected under similar rationale.

In regards to claim 91, Doss and Enright teach all the limitations of claim 39. They further teach a method wherein the notification information indicates whether the communications identity is available to communicate (See Doss, Column 8, Lines 8-44).

In regards to claim 92, Doss and Enright teach all the limitations of claim 91. They further teach a method wherein the notification information indicates whether the communications identity is logged on to a particular communications system(See Doss, Column 8, Lines 8-44).

In regards to claim 93, Doss and Enright teach all the limitations of claim 92. They further teach a method wherein the notification information indicates whether the communications identity is logged on to an instant messaging system (See Doss, Column 8, Lines 8-44).

In regards to claim 94, Doss and Enright teach all the limitations of claim 39. They further teach a method wherein the notification information indicates a geographic location of the communications identity (See Doss, Column 8, Lines 8-44).

Claim 95, 96 and 97 are similar in scope to claims 91, 92, and 94 respectively; therefore they are rejected under similar rationale.

Allowable Subject Matter

Claims 6-36, 44-53, 55-64, and 66-90 are allowed.

Claim 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: In regards to independent claims 36, 44, 53, 55, 64, 66, and 73, the prior art does not teach accessing information indicating that the first communications identity associated with a first mobile device is associated with a second communications identity such that the first communications identity corresponds to a person and the second communications identity corresponds to the same person; and making available

the geographical location information associated with the first mobile device to the communications identities of the instant messenger participant list associated with the second communications identity conditioned on the temporal conditioned being satisfied; in combination with all of the other claim limitations.

In regards to dependent claim 40, the prior art does not teach a method wherein the multiple categories comprise multiple categories in which at least two categories of the multiple categories are arranged in hierarchical relationship such that a lower category is related to a higher category; in combination with all of the other claim limitations.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (571) 272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BP

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